

## REMARKS

Applicants respectfully request reconsideration of the Office action dated October 11, 2001, in view of the foregoing amendments and following remarks.

### I. Rejection of Claims 12 and 14 Under 35 U.S.C. § 251

Claims 12 and 14 were rejected in the Office action as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. Applicants respectfully request that this rejection be withdrawn, since the present application was made and sworn to by the patentee. As indicated in the attached copy of the reissue declaration, the present reissue application was executed by Timothy A. Wurtz and Ronald D. Wurtz, the inventors named on the original patent.

### II. Rejection of Claims 5-6 and 8-10 Under 35 U.S.C. 103(a)

Claims 5-6 and 8-10 were rejected in the Office action under 35 U.S.C. 103(a) as being unpatentable over Crofoot (U.S. Patent No. 3,894,368) in view of Tansi (U.S. Patent No. 4,202,457). For the reasons set forth below, Applicants respectfully disagree with this rejection, and request that it be withdrawn.

The teachings of Tansi are not analogous to the problems addressed by Applicants' invention. In particular, Tansi discloses a foldable electrical outlet box having mounting nail sleeves 48. The mounting sleeves hold nails 42 that are used to permanently mount the electrical box to a building structure, such as a stud. By contrast, the present invention is directed to a floor joist retainer that is attached to a concrete form, instead of to a building. The floor joist retainer is temporarily attached to the form, instead of being permanently attached. In certain of Applicants' embodiments, the retainer is attached to the concrete

forms using nail posts that are attached to sides of the retainer body, as recited in claims 5, 8 and 9. After the joist retainer is attached to the forms, concrete is poured into the forms so as to surround the retainer. After the concrete sets around the retainer, the forms are removed, and the retainer leaves an opening for receiving the end of a joist.

Because the electrical outlet box of Tansi is permanently mounted to a building structure, the mounting mechanism must provide a long-lasting and secure attachment that is able to withstand various loads and strains, such as that imposed by attached wiring, and by plugging and unplugging devices into the electrical outlet. By contrast, the joist retainer of the present invention bears only temporary loads from poured concrete. These loads tend to be applied as uniform inward-directed pressure, instead of single-direction forces that would tend to compromise the attachment of the retainer to the form (e.g., as would be experienced with an electrical outlet box attached to a stud). For these reasons, the attachment mechanism in Tansi would not have commended itself to the attention of one who wanted to temporarily attach a floor joist retainer to a concrete foundation form. Tansi is thus non-analogous art, and the rejections under 35 U.S.C. based on Tansi should be withdrawn.

Moreover, for the reasons stated above, it is not proper to combine the teachings of Tansi with the teachings of Crofoot. As explained in section 2142 of the Manual of Patent Examining Procedure (8<sup>th</sup> Ed.), the patent office bears the initial burden of establishing a *prima facie* case of obviousness. This requires showing a suggestion or motivation to modify or combine references, and a reasonable expectation that the combination will be successful.

Crofoot addresses a socket for a beam end in the top of a poured concrete wall. As discussed above, this setting is very different from the electrical outlet discussed in Tansi. Accordingly, one skilled in the art would not be motivated to combine the teachings of

Crofoot and Tansi in order to produce a floor joist retainer such as that claimed by Applicants.

Accordingly, claims 5-6 and 8-10 are allowable, and the rejection of those claims based on Crofoot and Tansi should be withdrawn.

III. Rejection of Claims 15, 17 and 18 Under 35 U.S.C. 103(a)

Claims 15, 17 and 18 were rejected in the Office action under 35 U.S.C. 103(a) as being unpatentable over Crofoot. For the reasons set forth below, Applicants respectfully disagree with this rejection, and request that it be withdrawn.

Claim 15 recites a floor joist retainer body having a front, sides, back, bottom and top, with “at least one cut being provided on the floor joist retainer body where the top connects to the sides and back so that the top is removable.” This cut is also described on page 5, lines 1-5 of Applicants’ specification. Applicants’ joist retainer is provided with this cut during the manufacturing process, so as to facilitate eventual removal of the top during installation.

By contrast, the beam socket shown in Crofoot is not manufactured with any such cut. Instead, the Crofoot beam socket is cut during installation by an end-user (e.g., with a jackknife). Presumably to allow this cutting, Crofoot teaches that the beam socket is preferably made of “thin sheet molded plastic.” *See* col. 2, line 2. Because the material is already thin enough to easily cut with a jackknife (col. 2, lines 60-65), there would be no motivation to further facilitate cutting by providing a kiss cut or other area of diminished thickness. In addition, this modification to Crofoot would add a manufacturing step, thus further teaching away from such a modification of Crofoot. Because Crofoot does not disclose or suggest a cut as claimed by Applicants, and because there is no teaching or motivation to provide such a cut, the rejection of claims 15, 17 and 18 should be withdrawn.

**IV. Allowable Subject Matter Indicated in Office Action**

Applicants thank the Examiner for indicating that claims 1-3 and 7 are allowed, and for indicating that claims 11, 13 and 16 contain allowable subject matter. As discussed above, the independent claims from which claims 11, 13 and 16 depend are believed to be allowable. As such, claims 11, 13 and 16 are not being rewritten in independent form at this time.

**V. New Claims**

Claims 19 and 20 have been added by the foregoing amendment. Applicants believe that these claims distinguish the references of record, and are in condition for allowance.

**VI. Conclusion**

Accordingly, applicants respectfully request issuance of a Notice of Allowance in connection with the above-identified application. The Examiner is invited to call the undersigned at if there are any remaining issues that may be resolved by telephone conference.

Respectfully submitted,

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McCORMACK & HEUSER

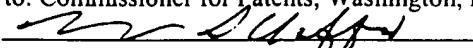
  
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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231 on March 11, 2002.

  
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